

REMARKS

This Amendment is in response to the Office Action dated April 17, 2003. Claims 1-26 are pending in this application. By this Amendment, Applicants have amended claims 1-16 to address the claim rejections under 35 U.S.C. § 112, second paragraph. Claim 17 was amended to include the recitation that the filter assembly is fixedly attached to a steerable guide wire. Claim 24 was amended to include the recitation that the plurality of recesses are formed for housing the plurality of splines of the filtering structure. Reconsideration of all of the pending claims is respectfully requested.

Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 1 has been amended to eliminate the terminology "near its distal end" in order to avoid any ambiguity. Claim 22, which included similar language but which was not rejected under 35 U.S.C. § 112, second paragraph, by the Examiner, also has been amended to delete this same language to avoid any ambiguity with respect to claims 22-26.

The Examiner has rejected claim 1-14, 15, 22, 23, 25 and 26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,391,044 to Yadav et al., (the "Yadav patent"). Applicants, however, disagree with the Examiner's characterization of various components shown in the Yadav patent. Specifically, the Examiner has relied on the embodiment of the filter delivery device shown in FIGS. 1 and 13 of the Yadav patent to

support the position that all of the limitations of claim 1 can be found. However, the component which has been identified as a guide wire (148) by the Examiner is not a guide wire at all but, rather, merely a moveable core which moves within the hollow guide wire (142) as shown in FIGS. 12 and 13 of the Yadav patent. Claim 1 has been amended to include the recitation that the filtering assembly is attached to a steerable guide wire. For this reason alone, the Yadav patent fails to disclose Applicants' claimed invention recited in claims 1-14 and 16. Moreover, claim 22 includes the recitation that the self-expanding filter structure is formed from a portion of the tubular shaft member. Yadav does not disclose such a construction in the specification directed to FIGS. 12 and 13, or, for that matter, to any of the other disclosed embodiments of the filter assembly. Accordingly, the Yadav patent fails to disclose the particular arrangement of components as defined by pending claims 22, 23, 25 and 26. For these reasons, Applicant respectfully requests the Examiner to withdraw the Yadav patent as an anticipatory reference with respect to all of the claims at issue.

The Examiner also has rejected claims 1, 5, 9, 10, 14, 15, 17, 18 and 22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,290,710 to Cryer et al., (the "Cryer patent"). Claim 1 has been amended to include the recitation that the sheath is fixedly attached to the guide wire. The Cryer patent fails to disclose a sheath which is fixedly attached to the guide wire. Rather, the Cryer patent shows a sheath (26) which moves along the guide wire (14) in a coaxial relationship. Accordingly, the Cryer patent fails to disclose the claimed invention of claims 1, 5, 9, 10, 14, 15, 17, and 18. Moreover,

the particular structure as recited by claim 22 is additionally not found in the Cryer patent. Again, as mentioned above, claim 22 requires that the self-expanding filtering structure be formed from a portion of the tubular shaft member. Cryer does not appear to disclose such an arrangement of elements. Accordingly, Applicants respectfully request the Examiner to withdraw the Cryer reference as an anticipatory reference to these claims at issue.

Claims 19, 20, 21, 23, 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Cryer patent in view of the Yadav patent. Applicants respectfully submit that the Cryer patent and the present application were, at the time the presently claimed invention was made, each either owned by or subject to an obligation of assignment to Advanced Cardiovascular Systems, Inc. Applicants direct the Examiner's attention to the recorded assignment of the present inventor to Advanced Cardiovascular Systems, Inc., which is recorded at Reel/Frame 010941/0016 on July 13, 2003. In view of the statement of common ownership presented herein, Applicants respectfully asserts that the Cryer patent is not a valid 35 U.S.C. § 103 reference and traverse the rejections. MPEP 706.02 (I)(2).

The present application was filed after the November 22, 1999 effective date of change to 35 U.S.C. § 103(c) which disqualifies § 102(e) prior art from consideration under § 103 if the subject matter of the reference and the claimed invention were commonly owned at the time the claimed invention was made. The Cryer patent has been cited in the current Office action as a 35 U.S.C. § 102(e) reference. Applicants have

made herein a statement this patent and the present application were, at the time the invention was made, each either owned by or subject to an obligation of assignment to the same company. Accordingly, Applicants submit that the Cryer patent is disqualified as prior art under § 103 against the present application. Applicants respectfully request the Examiner to withdraw the U.S.C. § 103(a) rejection as applied to these pending claims.

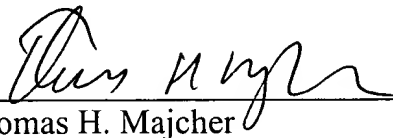
Without the teachings of the Cryer patent, the only remaining § 103 rejection is that of claim 24 over the Yadav patent in view of U.S. Patent No. 5,108,419 to Reger et al. (the "Reger patent"). As mentioned above, claim 24 has been amended to recite that the plurality of recesses formed in the tubular shaft member are utilized for housing the plurality of splines which form the self-expanding filtering structure in Applicants' claimed invention. Also, as mentioned above, the Yadav patent fails to disclose the particular combinations of elements recited by claim 22. The Reger patent does not disclose a self-expanding filtering structure formed from a portion of the tubular shaft member. Accordingly, the combination of the Yadav patent with the Reger patent fails to achieve the particular combination of elements recited in claim 24. Therefore, Applicants respectfully request that the § 103(a) rejection be withdrawn.

In view of the foregoing, it is respectfully urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at 310-824-5555 to facilitate prosecution of this application, if necessary.

In light of the above amendments and remarks, applicant respectfully requests that
a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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